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OFFICE OF PETITIONS

In re Application of
Williams, et al.
Application No. 10/622,134
Filed: July 18, 2003
Attorney Docket No. 550-453
For: EOTAXIN : EOSINOPHIL CHEMOTACTIC
CYTOKINE

ON PETITION

This is a decision on the petition filed November 14, 2003, requesting, in effect, withdrawal of a Notice mailed January 7, 2004, insofar as it alleges that Figures 3-5 were omitted from the original filing. The petition will be treated under 37 CFR 1.53(e).

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Petitioner is advised that this is not a final agency decision.

The application was filed on July 18, 2003. However, on January 7, 2004, The Office of Initial Patent Examination mailed a "Notice to File Missing Part(s) of Nonprovisional Application" (Notice) stating, *inter alia*, that the application had been accorded a filing date of July 18, 2003, and advising applicants that Figures 3-5, as referenced in the specification, appeared to have been omitted. In response, the present petition was filed.

Petitioners assert that seven sheets of drawings, including allegedly omitted Figures 3-5, which were copies of those in parent application no. PCT/GB94/02006, and an additional 7 sheets of drawings were received in the Office on July 18, 2003. In support, the petition is accompanied by a copy of applicants' itemized postcard receipt showing an Office of Initial Patent Examination date stamp citing July 18, 2003 as the date of receipt. The postcard lists, *inter alia*, that the filing included 7 sheets of drawings and 7 additional sheets of drawings.

The return postcard constitutes *prima facie* evidence that 14 sheets of drawings were filed on July 18, 2003. MPEP 503.

Unfortunately, the only drawings present in the application file are the additional 7 sheets of drawings, which admittedly do not contain a sheet of drawings depicting Figures 3-5. The eight sheets of formal drawings submitted with the instant petition are clearly not the seven sheets of drawings from the parent application.

The Office requires the original seven sheets of drawings be submitted. Then the Office will be able to compare the original seven sheets of drawings to the eight sheets of formal drawings

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submitted on November 14, 2003. The Office cannot process the November 14, 2003 sheet of drawings containing Figures 3-5 because that sheet -- "2/8"-- was not present upon initial filing and the Office cannot ascertain whether Figures 3-5 as depicted on sheet "2/8" matches what was filed in the Office on July 18, 2003.

Petitioners should submit a reconsideration petition accompanied by the original seven sheets of drawings from the parent application and a request that the eight sheets of drawing filed on November 14, 2003 be used for processing purposes. If Figures 3-5 were among those figures filed on July 18, 2003, then the reconsideration petition will be granted and the petition fee will be refunded.

If the original 7 sheets of drawing figures do not contain Figures 3-5, petitioners may seek to add the figures to the present application on the basis that the figures are not new matter because they were originally filed in parent applications, the entire disclosures of which were incorporated by reference at the time of filing.

Additional figures may be entered by the primary examiner without a petition so long as the figures contain no new matter. See MPEP § 608.02(a). If petitioners select this avenue for relief, the petition fee will not be refunded, since the petition was not necessitated by any error on the part of the Office.

MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

If applicants desire that Figures 3-5 be added to the application, the appropriate procedure is by way of amendment requesting the entry of the figures. Any such amendment should be filed prior to the first action on the merits and will be considered by the primary examiner.

Petitioners are requested to submit an additional copy of the parent's declaration because there is no declaration present in the application file, although the Office acknowledged receipt of a one page declaration on July 18, 2003.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450
ATTN: E. Shirene Willis

By hand: Crystal Plaza 1 Lobby
2011 South Clark Place
Room 1B03
Arlington, VA 22202
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By FAX: (703) 872-9306
ATTN: Office of Petitions -- E. Shirene Willis

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of **July 18, 2003**. The sheet of drawings containing Figures 3-5 submitted with the instant petition will **not** be processed at this time.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6712.



E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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